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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
for FY 2006

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 500.00

Complete if Known	
Application Number	09/994,410
Filing Date	November 27, 2001
First Named Inventor	Carolynn Rae Johnson
Examiner Name	James A. Fletcher
Art Unit	2616
Attorney Docket No.	PU010272

METHOD OF PAYMENT *(check all that apply)* **CUSTOMER NUMBER: 24498**

☐ Check ☐ Credit card ☐ Money Order ☐ None ☐ Other (please identify): _____

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FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

	FILING FEES		SEARCH FEES		EXAMINATION FEES		
		Small Entity		Small Entity		Small Entity	
Application Type	**Fee ($)**	**Fee ($)**	**Fee ($)**	**Fee ($)**	**Fee ($)**	**Fee ($)**	**Fees Paid ($)**
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Small Entity Fee ($)	Small Entity Fee ($)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims		**Extra Claims**	**Fee ($)**	**Fee Paid ($)**
_____	- 20 or HP =	_____	x _____	= _____

HP = highest number of total claims paid for, if greater than 20.

Independent Claims		**Extra Claims**	**Fee ($)**	**Fee Paid ($)**
_____	- 3 or HP =	_____	x _____	= _____

HP = highest number of independent claims paid for, if greater than 3.

Multiple Dependent Claims	
Fee ($)	**Fee Paid ($)**
_____	_____

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets		**Extra Sheets**		**Number of each additional 50 or fraction thereof**	**Fee ($)**	**Fee Paid ($)**
_____	- 100 =	_____	/ 50 =	_____ (round **up** to a whole number) x	_____	= _____

4. OTHER FEE(S)

	Fees Paid ($)
Non-English Specification, $130 fee (no small entity discount)	
Other (e.g., late filing surcharge): **Appeal Brief**	500.00

SUBMITTED BY

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AFS
IFW

CUSTOMER NO.: 24498

PATENT
Atty. Dkt. No. PU010272

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Carolynn Rae Johnson §
§
Serial No.: 09/994,410 § Group Art Unit: 2616
§
Confirmation No.: 7497 § Examiner: James A. Fletcher
§
Filed: November 27, 2001 §
§
For: **METHOD AND SYSTEM FOR VIDEO RECORDING COMPILATION** §
§
§

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING
37 CFR 1.8
I hereby certify that this correspondence is being deposited on March 16, 2006 with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

March 16, 2006 Lori Kleeman
Date Signature

APPEAL BRIEF

Dear Sir:

Appellant submits this Appeal Brief to the Board of Patent Appeals and Interferences on appeal from the decision of the Examiner of Group Art Unit 2616 dated December 27, 2005, finally rejecting claims 23-26 and 30-42 as examined by the Examiner. It should be noted that the Examiner prosecuted claims 40-42 as claims 27-29 in his rejections. That is, the Examiner never made reference in his rejections to the Appellant's claims 40-42 and instead considered the Appellant's claims 40-42 as claims 27-29 in his rejections.

Table of Contents

Real Party in Interest

The real party in interest is Thomson Licensing S.A.

Related Appeals and Interferences

Appellant asserts that no other appeals or interferences are known to the Appellant, the Appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

Claims 1-22 were originally presented in the application. Claims 1-22 were cancelled in prosecution and new claims 23-38 were added. Subsequently, claims 27-29 were cancelled in prosecution and claims 39-42 were added. Claims 23-26, 28-33 and 35-39 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Ellis et al. (US Patent Application Publication No. 2002/0174430) and claims 27 and 34 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis et al. in view of Okada (U.S. Patent 6,181,870). The rejection of claims 23-26 and 30-42 based on the cited, respective references is appealed. The pending claims are shown in the attached Appendix. It should be noted that the Examiner prosecuted claims 40-42 as claims 27-29 in his rejections.

Status of Amendments

A first response was filed on February 17, 2004 to overcome a First Office Action dated August 14, 2003. In the First Office Action, the Examiner rejected the Appellant's claims 1-4, 6-8, 10-15, 17-19, 21 and 22 under 35 U.S.C. § 102(b) as being anticipated by Okada et al. (6,181,870). The Examiner further rejected the Appellant's claims 1, 3, 12 and 14 under 35 U.S.C. § 102(b) as being anticipated by Kazami et al. (6,035,093). Even further, in the First Office Action, the Examiner rejected the Appellant's claims 5, 9, 16 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Okada et al. in view of Saito et al. (U.S. Patent 6,085,020). In the response filed on February 17, 2004, the Appellant cancelled claims 1-22 and added claims 23-39. The Appellant further set forth arguments traversing the rejections issued by the Examiner.

A second response was filed on October 28, 2004 in an attempt to overcome a Final Office Action dated May 05, 2004. In the Final Office Action, the Examiner rejected the Appellant's claims 28-30 and 39 under 35 U.S.C. § 112 for depending on a non-existent claim due to inadvertent numbering errors. The Examiner further rejected the Appellant's claims 23, 25-26, 30-31 and 33-35 under 35 U.S.C. § 102(b) as being anticipated by Okada et al. Even further, in the Final Office Action, the Examiner rejected the Appellant's claims 24, 32 and 36-37 under 35 U.S.C. § 103(a) as being unpatentable over Okada et al. in view of Saito et al. In the response filed on October 28, 2004, the Appellant amended and renumbered claims 23 and 27-38 to overcome formality rejections and to more clearly define the invention of the Appellant. The Appellant further added claim 39 and set forth more detailed arguments traversing the rejections issued by the Examiner and requesting reconsideration.

The Examiner responded to the Appellant's response of October 28, 2004 with an Advisory Action dated December 13, 2004. In the Advisory Action, the Examiner stated that the Appellant's response to the Final Office Action did not place the Appellant's application in condition for allowance and that the proposed amendments in the response of October 28, 2004 would not be entered because they raise new issues that would require further consideration or search.

On January 7, 2005, the Appellant filed a Petition for Revival of an application for patent abandoned unintentionally. In response, on April 28, 2005, the Office of Petitions

mailed a Decision of Patents dismissing the Appellant's Petition of Revival filed on January 7, 2005, indicating that the Petitioner did not submit the required reply to the Final Office Action.

On May 06, 2005, the Appellant filed a Renewed Petition for Revival of an application for patent abandoned unintentionally, an RCE and a preliminary amendment, amending the Appellant's application as indicated in the previously submitted response to the Final Office Action dated October 28, 2004 however adding claims 39-42 and deleting claims 27-29. The Petition for Revival was granted by the Office of Petitions on May 31, 2005.

A first response after revival was filed on September 30, 2005 to overcome a First Office Action after revival dated July 15, 2005. In the Office Action, the Examiner rejected the Appellant's claims 23-26, 28-33 and 35-39 under 35 U.S.C. § 102(e) as being anticipated by Ellis et al. (US Patent Application Publication 2002/0174430). The Examiner further rejected the Appellant's claims 27 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Ellis et al. in view of Okada et al. (U.S. Patent 6,181,870). In the response filed on September 30, 2005, the Appellant set forth arguments traversing the rejections issued by the Examiner. It should again be noted that the Examiner prosecuted claims 40-42 as claims 27-29 in his rejections.

The Examiner responded to the Appellant's response of September 30, 2005 with a Final Office Action dated December 27, 2005. In the Final Office Action, the Examiner reiterated his rejections of the previous Office Action dated July 15, 2005. In response to the Final Office Action, the Appellant submitted a Notice of Appeal dated January 19, 2006.

The claims on appeal are those of the Preliminary Amendment filed on May 06, 2005 along with the Appellant's RCE and Renewed Petition for Revival of an application for patent abandoned unintentionally. The claims on appeal are the Appellant's claims 23-26 and 30-42, however, it should again be noted that the Examiner prosecuted claims 40-42 as claims 27-29 in his rejections.

Summary of Claimed Subject Matter

The invention of the Appellant provides a method and system for generating a customized video recording compilation. In one embodiment, the invention can include the presentation of a menu which lists at least a portion of video segments recorded on a first storage medium, the prompting of a user to select at least one video segment from the menu, the compilation of each video segment selected by the user to create at least one compilation, and the insertion of the compilation as a new item in the menu. In various embodiments, the method and system of the present invention can further include the transferring of a video segment in the compilation from the first storage medium to a second storage medium. Even further, in various embodiments of the present invention, a plurality of video segments in the compilation can be transferred automatically from the first storage medium to a second storage medium without any user interaction.

As suggested in MPEP 1206, the Appellant now reads at least two of the broadest appealed claims on the specification and on the drawings. It should be understood, however, that the appealed claims may read on other portions of the specification or other figures that are not listed below.

With regards to at least the Appellant's system claim 31, the Appellant's Specification specifically states that a system 100 of the present invention can include a controller 110 for reading data from and writing data to a first storage medium 112. The first storage medium 112 of the system can include one or more menus for listing one or more video segments have been recorded on the first storage medium 112. The system 100 can also have a microprocessor 114, a decoder 116, an encoder 118 and a display device 120. In addition, it is understood that all or portions of the controller 110, the microprocessor 114 and in certain cases the encoder 118 can be a processor 122 within contemplation of the present invention. Similarly, all or portions of the controller 110, the first storage medium 112, the microprocessor 114, the decoder 116, and the encoder 118 can be a first storage medium device 124 within contemplation of the present invention. The system 100 can also include a second storage medium device 126.

Control and data interfaces can also be provided for permitting the microprocessor 116 to control the operation of the controller 112, the decoder 116 and the encoder 118. Suitable software or firmware can be provided in memory for the conventional operations performed by the microprocessor 114. Further, program routines can be provided for the microprocessor 114 in accordance with the inventive arrangements.

In operation, a user can access a menu from the first storage medium 112 through a user command received by the microprocessor 114. This menu can be displayed on the display device 120. The user can then select one or more video segments from the menu for purposes of generating a compilation. The microprocessor 114, in conjunction with the controller 110, can then insert the compilation into the menu.

In addition and with regards to at least the Appellant's method claim 23, the Appellant's Specification specifically teaches all of the aspects of at least the Appellant's method claim 23. That is, the Specification teaches a flowchart 200 that demonstrates one way in which a video recording compilation can be generated. At step 210, the process can begin. At step 212, a menu, which can list at least a portion of video segments recorded onto a first storage medium, can be provided. The term video segment can be any portion of previously recorded video and is not necessarily limited to an entire unit of programming such as a complete movie or television show. The menu can list the name of the video segment, when it was created and the channel from which the segment was recorded.

At step 214, a user can be prompted to select at least one video segment from the menu. Once he or she has selected the desired video segments, the user can choose the order compilation option, and the user can be prompted to place the video segments (if more than one video segment is selected form the menu) in a desired viewing order. The video segments can then be placed in this order to reflect a customized viewing sequence.

In another arrangement, the user can choose the name compilation option and can create an identifier for the compilation. Once the identifier has been created, the compilation can be designated with the identifier. Similar to the order compilation

option, if the user does not create an identifier, then a default identifier can be created.

Referring once again to the flowchart 200, at decision block 216, if all the selections are complete, each video segment selected by the user can be compiled to create at least one compilation, as shown at step 218. At step 220, the compilation can be inserted in the menu as a new item. Thus, the user can now access the newly generated customized video recording compilation for purposes of viewing a specific set of video segments. If the user wishes, these video segments can be placed in a preferred viewing order and can be easily located through the identifier.

For the convenience of the Board of Patent Appeals and Interferences, Appellants' pending claims are presented below in claim format with elements read on the drawings and appropriate citations to at least one portion of the specification for each element of the appealed claims (with reference numerals added).

Claim 23 positively recites (with reference numerals added, where applicable):

> 23. A method of creating a video program list comprising the steps of:
> presenting (212) a menu including a first program list of recorded programs;
> identifying (212) each of said recorded programs in said menu using a title that refers to at least one of a subject matter and an artistic content of said recorded programs;
> prompting (214) a user to identify at least one recorded program from said first program list to be included in a second program list;
> creating (218) said second program list, including the at least one identified program;
> creating (218) an identifier corresponding to said second program list;
> including (220) said identifier as a selectable item of said menu.
> (See Appellant's specification, page 5, line 17 through page 6, line 31, and page 4, lines 31-33).

Claim 24 positively recites (with reference numerals added, where applicable):

> 24. The method according to claim 23 wherein at least a first recorded program of said plurality of recorded programs is stored on a first storage medium (112) and at least a second recorded program of said plurality of recorded programs is stored on a second storage medium (126).
> (See Appellant's specification, page 5, lines 1-9 and page 7, lines 3-5).

Claim 25 positively recites (with reference numerals added, where applicable):

> 25. The method according to claim 23 wherein said programs are represented on said menu by means of a program title. (See Appellant's specification, page 5, lines 22-24).

Claim 26 positively recites (with reference numerals added, where applicable):

> 26. The method according to claim 23, further comprising the steps of:
> prompting said user to select an order for the programs comprising said second list; and
> playing back the video programs comprising said second list in the selected order. (See Appellant's specification, page 6, lines 4-8).

Claims 27-29 (Cancelled)

Claim 30 positively recites (with reference numerals added, where applicable):

> 30. A method of generating a video recording and playback list, comprising the steps of:
> displaying (212) a menu including a plurality of recorded programs;
> identifying (212) each of said recorded programs in said menu using a title that refers to at least one of a subject matter and an artistic content of said recorded programs;
> creating (218) a list comprising user identified ones of said plurality of recorded programs;
> modifying (220) said menu to include said list as a selectable item on said menu. (See Appellant's specification, page 5, line 17 through page 6, line 31 and page 4, lines 31-33).

Claim 31 positively recites (with reference numerals added, where applicable):

> 31. A system for generating a video recording and playback list comprising:
> a display device (120) capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content,
> said device (120) operable to allow a user to indicate at least two individual ones of said plurality of programs;

said device including a processor (122) programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list;

said processor (122) programmed to modify said menu to include said identifier as a user selectable item of said menu. (See Appellant's specification, page 4, lines 11-33).

Claim 32 positively recites (with reference numerals added, where applicable):

32. The system according to claim 31, wherein said processor (122) is further programmed to transfer video programs corresponding to said indicated items from a first storage medium (112) to a second storage medium (126) in response to user selection of said identifier. (See Appellant's specification, page 5, lines 1-14).

Claim 33 positively recites (with reference numerals added, where applicable):

33. The system according to claim 31, wherein said device (120) is operable to allow a user to order said indicated items and wherein said processor (122) is further programmed to playback said programs according to said order in response to selection of said identifier. (See Appellant's specification, page 6, lines 4-8).

Claim 34 positively recites (with reference numerals added, where applicable):

34. The system according to claim 31, wherein said processor (122) is further programmed to automatically transfer all programs comprising said list from a first storage medium (112) to a second storage medium (126) in response to a single user selection of said identifier. (See Appellant's specification, page 7, lines 25-32).

Claim 35 positively recites (with reference numerals added, where applicable):

35. The system according to claim 31, wherein the processor (122) is further programmed to allow said user to specify said identifier. (See Appellant's specification, page 6, lines 13-15).

Claim 36 positively recites (with reference numerals added, where applicable):

36. The system according to claim 32 wherein said first storage medium (112) is selected from the group comprising: optical disc media, magneto disc media, digital tape media, analog tape media, and hard disc drive(HDD). (See Appellant's specification, page 5, lines 27-30).

Claim 37 positively recites (with reference numerals added, where applicable):

37. The system according to claim 32, wherein said second storage medium (126) is selected from the group comprising: optical disc media, magneto disc media, digital tape media, analog tape media and hard disc drive(HDD). (See Appellant's specification, page 7, lines 18-20).

Claim 38 positively recites (with reference numerals added, where applicable):

38. The method of claim 30 wherein said steps are accomplished without modifying video and audio program content of said indicated programs. (See Appellant's specification, page 8, lines 7-8).

Claim 39 positively recites (with reference numerals added, where applicable):

39. The method according to claim 23 further comprising the step of transferring selected programs from a first storage medium (112) to a second storage medium (126) by selecting said identifier from said menu. (See Appellant's specification, page 7, lines 11-15).

Claim 40 positively recites (with reference numerals added, where applicable):

40. The method according claim 39, wherein said transferring step further comprises the step of automatically transferring programs comprising said second list from said first storage medium (112) to said second storage medium (126) without any user interaction following user selection of said identifier. (See Appellant's specification, page 7, line 21 through page 8, line 8).

Claim 41 positively recites (with reference numerals added, where applicable):

41. The method according to claim 39, wherein said first storage medium (112) is selected from the group comprising: optical disc media, magneto disc media, digital tape medium, analog tape medium and hard disc drive (HDD). (See Appellant's specification, page 5, lines 27-30).

Claim 42 positively recites (with reference numerals added, where applicable):

> 42. The method according to claim 39, wherein said second storage medium is selected from the group comprising optical disc media, magneto disc media, digital tape medium, analog tape medium and hard disc drive (HDD). (See Appellant's specification, page 7, lines 18-20).

Grounds of Rejections to be Reviewed on Appeal

1. Whether the Appellant's claims 23-26, 30-33, 35-39 and 41-42 (considered claims 28 and 29 by the Examiner in his rejections) are patentable under 35 U.S.C. § 102(e) over Ellis et al. (US Patent Application Publication No. 2002/0174430, hereinafter "Ellis").

2. Whether the Appellant's claims 40 (considered claim 27 by the Examiner in his rejections) and 34 are patentable under 35 U.S.C. §103(a) over Ellis in view of Okada (U.S. Patent 6,181,870).

3. Pending claims 23-26, 30-33, 35-39 and 41-42 (considered claims 28 and 29 by the Examiner in his rejections) have been grouped together by the Examiner in their rejection. In addition, claims 40 (considered claim 27 by the Examiner in his rejections) and 34 have also been grouped together by the Examiner in their rejection. Appellant urges that each of the rejected claims stands on its own recitation, the claims being considered to be separately patentable for the reasons set forth in more detail *infra*.

ARGUMENT

I. THE EXAMINER ERRED IN REJECTING CLAIMS 23-26, 30-33, 35-39 AND 41-42 UNDER 35 U.S.C. § 102(e) BECAUSE THE CITED REFERENCE FAILS TO TEACH, SUGGEST OR ANTICIPATE AT LEAST A METHOD AND SYSTEM OF CREATING A VIDEO PROGRAM LIST INCLUDING "CREATING A SECOND PROGRAM LIST, INCLUDING THE AT LEAST ONE IDENTIFIED PROGRAM", "CREATING AN IDENTIFIER CORRESPONDING TO SAID SECOND PROGRAM LIST" AND "INCLUDING SAID IDENTIFIER AS A SELECTABLE ITEM OF SAID MENU".

A. 35 U.S.C. § 102(e) - Claim 23

The Examiner rejected the Appellant's claim 23 under 35 U.S.C. § 102(e) as being anticipated by Ellis et al. ((U.S. Patent App. Publication 2002/0174430, hereinafter "Ellis"). The rejection is respectfully traversed.

The Examiner alleges that regarding claim 23, Ellis discloses a method for creating a video program list including all of the limitation of the Appellant's invention. The Appellant respectfully disagrees.

The Appellant submits that the Ellis reference fails to teach, suggest or disclose each and every element of at least the invention as recited in the Appellant's independent claim 23, which specifically recites:

> "A method of creating a video program list comprising the steps of:
> presenting a menu including a first program list of recorded programs;
> identifying each of said recorded programs in said menu using a title that refers to at least one of a subject matter and an artistic content of said recorded programs;
> prompting a user to identify at least one recorded program from said first program list **to be included in a second program list;**
> **creating said second program list, including the at least one identified program;**
> **creating an identifier corresponding to said second program list**; and
> **including said identifier as a selectable item of said menu.**" (emphasis added).

More specifically, the Appellant's claim 23 is directed at least in part to a method of creating a video program list in which a user is prompted to identify at least one recorded program from a first program list to be included in a second program list, creating the second program list including the identified recorded programs, creating an identifier for the second program list, and including the identifier of the second program list as a selectable item of a menu including at least the first list. In support of at least claim 23, the Appellant in the Specification specifically recites:

> "Once he or she has selected the desired video segments, the user can choose the order compilation option, and the user can be prompted to place the video segments (if more than one video segment is selected form the menu) in a desired viewing order. The video segments can then be placed in this order to reflect a customized viewing sequence. An example of this step is shown at FIG. 5. If the user does not select a particular viewing order, then the viewing segments can be placed in a random or default viewing sequence that could be based on any number of schemes including the chronological recording dates of each video segment selected, for example.
>
> In another arrangement, the user can choose the name compilation option and can create an identifier for the compilation. Once the identifier has been created, the compilation can be designated with the identifier. An example of this identification process is shown at FIG. 6." (See Specification, page 6, lines 9-21).

And

> "Referring once again to the flowchart 200, at decision block 216, if all the selections are complete, each video segment selected by the user can be compiled to create at least one compilation, as shown at step 218. At step 220, the compilation can be inserted in the menu as a new item. FIG. 7 shows an example of a menu in which the newly generated compilation has been inserted in the menu. Thus, the user can now access the newly generated customized video recording compilation for purposes of viewing a specific set of video segments." (See Specification, page 6, line 28 through page 7, line 2).

As evident from at least the portions of the Appellant's disclosure presented above, in the invention of the Appellant, once a user has selected the desired video segments, the user can place the video segments in a desired viewing order in a second program list as evidenced by FIG. 5 of the Appellant's application. That is, the Appellant's FIG. 5 specifically depicts a second program list of video segments identified by a user to be included in a video compilation in accordance with the Appellant's

invention. As further evidenced by at least the portions of the Appellant's disclosure presented above, in the invention of the Appellant, a user can create an identifier for the compilation in the second program list. Once the identifier has been created, the compilation can be designated with the identifier. The video segments selected by the user compiled to create at least one compilation, which is identified by the identifier, are inserted as a new item in a menu containing a first program list.

The Appellant respectfully submits that Ellis fails to teach, suggest or anticipate at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed by at least the Appellant's claim 23. More specifically, in contrast to the invention of the Appellant, Ellis teaches methods and systems that provide enhanced personal video recorder ("PVR") and interactive television program guide ("IPG") functionality. In Ellis the application may be used to display a list of PVR recordings, to schedule recordings to a PVR, to configure recordings, to view a list of scheduled recordings, to configure recording settings, or to select delete priority settings for recordings. However, there is absolutely no teaching, suggestion or disclosure in Ellis for at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed by at least the Appellant's claim 23.

More specifically, the Examiner cites paragraph 0378 of Ellis for teaching each and every element of the Appellant's claimed invention. The Appellant respectfully disagrees. In paragraph 0378, Ellis specifically recites:

> "Display screen 9616 may include recording listings 9618 which may contain a list of PVR recordings. Display screen 9616 may include combine after option 9620 and combine before option 9622. Display screen 9616 may provide the user with the ability to move highlight window 9632 over a listing bar in recording listings 9618 and to select combine after option 9620 or combine before option 9622 for the recording identified in that listing bar. A user may be permitted to move a highlight window between listings 9618 and options 9620 and 9622 using right and left remote control navigation

> keys. A user may be permitted to move highlight window 9632 over a particular listing (e.g., Sports Center) and to combine a recording of that particular listing with a currently selected recording by adding the recording of that particular listing before or after the currently selected recording. By using remote control right and left navigation keys, a user may access combine after option 9620 or combine before option 9622 for that particular listing. Pressing a remote control "OK" key will then cause the recording for that particular listing to be combined with currently selected recording. Display screen 9616 may also include the title, length, and other information related to the currently selected recording. The combined recording may have the name of the originally selected program, the name of the program selected to be combined with it, the user may be able to choose which name to use, or the user may be allowed to enter a new name for the combination. If desired, neither, either or both of the original recordings may be deleted when the combination is created." (See Ellis, paragraph 0378).

In contrast to the invention of the Appellant, in Ellis there is absolutely no teaching, suggestion or disclosure of "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed by at least the Appellant's claim 23. Instead of creating a second program list as taught and claimed in the Appellant's invention, in Ellis a Display screen 9616 provides a user with the ability to move a highlight window 9632 over a listing bar in recording listings 9618 and to select combine after option 9620 or combine before option 9622 for the recording identified in that listing bar. As such in Ellis, a user is permitted to move a highlight window 9632 over a particular listing (e.g., Sports Center) and to combine a recording of that particular listing with a currently selected recording by adding the recording of that particular listing before or after the currently selected recording. Again, this is accomplished in Ellis by moving a window over a particular listing and not be creating a second program listing displaying video segments a user wishes to include in a compilation as taught and claimed by at least the Appellant's claim 23.

In addition, there is absolutely no teaching, suggestion or disclosure in Ellis for "creating an identifier corresponding to said second program list" as taught in the Appellant's Specification and claimed by at least the Appellant's claim 23. Instead of creating an identifier corresponding to the second program list as taught and claimed in

the Appellant's invention, in Ellis a combined recording may have the name of the originally selected program, the name of the program selected to be combined with it, or the user may be allowed to enter a new name for the combination. That is, in Ellis a name is chosen for the combination and not for a second program list as taught and claimed by at least the Appellant's claim 23.

Even further, there is absolutely no teaching, suggestion or disclosure in Ellis for "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed by at least the Appellant's claim 23. Instead of including the created identifier as a selectable item of the original menu as taught and claimed in the Appellant's invention, in Ellis neither, either or both of the original recordings may be deleted when the combination is created. That is, in Ellis, a name chosen for the combination is added to the menu and not an identifier for a second program list as taught and claimed by at least the Appellant's claim 23.

More specifically, the invention of Ellis is unable to perform the taught and claimed functionality of the Appellant's invention. More specifically, in the invention of the Appellant at least with respect to claim 23, a second program list is created from recorded programs identified by a user to be included in the second program list. In this second program list a user is able to place the identified recorded programs in any order for combination and display. In contrast, in the invention of Ellis, a highlight window is moved over an existing bar to combine the highlight window either before or after the existing bar. Subsequently, if a second highlight window is chose for combination with the combination of the first highlight window and the existing bar, the only option is to combine the second highlight window before or after the existing combination. In contrast, in the invention of the Appellant, at least because of the taught and claimed second program list, a user is able to arrange any number of identified recorded programs in any order in the second program list for compilation and subsequent viewing in the arranged order. The Appellant respectfully submits that Ellis falls far short of the Appellant's invention as taught and claimed at least with respect to independent claim 23 and that the invention of Ellis is unable to perform at least the above described functionality of the Appellant's invention.

Since Ellis fails to disclose or suggest all of the elements of the Appellant's claim 23, the Appellant respectfully submits that claim 23 is in condition for allowance for at least the reasons stated above. That is, the Appellant submits that for at least the reasons recited above independent claim 23 is not anticipated by the teachings of Ellis and, as such, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

B. 35 U.S.C. § 102 - Claim 24

Claim 24 depends directly from independent claim 23 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 23, the Appellant respectfully submits that dependent claim 24 is also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 23. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claim 23 further limited by "wherein at least a first recorded program of said plurality of recorded programs is stored on a first storage medium and at least a second recorded program of said plurality of recorded programs is stored on a second storage medium" as recited in claim 24.

That is, and for at least the same reasons provided in Section A above, at least because Ellis fails to teach, suggest or anticipate at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 24, which depends directly from independent claim 23. Therefore, the Appellant submits that claim 24, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

C. 35 U.S.C. § 102 - Claim 25

Claim 25 depends directly from independent claim 23 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 23, the Appellant respectfully submits that dependent claim 25 is also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 23. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claim 23 further limited by "wherein said programs are represented on said menu by means of a program title" as recited in claim 25.

That is, and for at least the same reasons provided in Section A above, at least because Ellis fails to teach, suggest or anticipate at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 25, which depends directly from independent claim 23. Therefore, the Appellant submits that claim 25, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

D. 35 U.S.C. § 102 - Claim 26

Claim 26 depends directly from independent claim 23 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 23, the Appellant respectfully submits that dependent claim 26 is also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 23. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claim 23 further limited by "prompting said user to select an order for the programs comprising said second list; and playing back the video programs comprising said second list in the selected order" as recited in claim 26.

That is, and for at least the same reasons provided in Section A above, at least because Ellis fails to teach, suggest or anticipate at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 26, which depends directly from independent claim 23. Therefore, the Appellant submits that claim 26, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

E. 35 U.S.C. § 102 - Claims 27-29

The Appellant's claims 27-29 were cancelled during prosecution. However, the Examiner prosecuted the Appellant's claims 40-42 as claims 27-29 in his rejections. The patentability of the Appellant's claims 40-42 is discussed below.

F. 35 U.S.C. § 102 - Claim 30

Claim 30 is an independent claim that recites similar relevant features as recited in the Appellant's independent claim 23. More specifically, claim 30 recites "creating a list comprising user identified ones of said plurality of recorded programs" and "modifying said menu to include said list as a selectable item on said menu."

As described in section A above, the teachings of Ellis absolutely fail to teach, suggest or anticipate at least "creating said second program list, including the at least one identified program" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23 and as similarly claimed in the Appellant's claim 30 reciting "creating a list comprising user identified ones of said plurality of recorded programs" and "modifying said menu to include said list as a selectable item on said menu." That is, the Appellant respectfully submits that independent claim 30 is also not anticipated by Ellis and is allowable for at least the reasons stated above with respect to independent claim 23.

Therefore, the Appellant submits that claim 30, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

G. 35 U.S.C. § 102 - Claim 31

Claim 31 is an independent system claim that recites similar relevant features as recited in the Appellant's independent method claims 23 and 30. More specifically, claim 31 recites "a display device capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content", "said device operable to allow a user to indicate at least two individual ones of said plurality of programs", "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu."

As described in sections A and F above, the teachings of Ellis absolutely fail to teach, suggest or anticipate at least "creating said second program list, including the at least one identified program" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23 and as similarly claimed in the Appellant's claim 30 reciting at least "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu." As such, the Appellant respectfully submits that independent claim 31 is also not anticipated by Ellis and is allowable for at least the reasons stated above with respect to independent claims 23 and 30.

Therefore, the Appellant submits that claim 31, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

H. 35 U.S.C. § 102 - Claim 32

Claim 32 depends directly from independent claim 31 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's

independent claim 31, the Appellant respectfully submits that dependent claim 32 is also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 31. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claim 31 further limited by "wherein said processor is further programmed to transfer video programs corresponding to said indicated items from a first storage medium to a second storage medium in response to user selection of said identifier" as recited in claim 32.

That is, and for at least the same reasons provided in Sections A and G above, at least because Ellis fails to teach, suggest or anticipate at least a method and system of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23 and "a display device capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content", "said device operable to allow a user to indicate at least two individual ones of said plurality of programs", "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu" as recited in claim 31, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 32, which depends directly from independent claim 31.

Therefore, the Appellant submits that claim 32, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

I. 35 U.S.C. § 102 - Claim 33

Claim 33 depends directly from independent claim 31 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 31, the Appellant respectfully submits that dependent claim 33 is

also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 31. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claim 31 further limited by "wherein said device is operable to allow a user to order said indicated items and wherein said processor is further programmed to playback said programs according to said order in response to user selection of said identifier" as recited in claim 33.

That is, and for at least the same reasons provided in Sections A and G above, at least because Ellis fails to teach, suggest or anticipate at least a method and system of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23 and "a display device capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content", "said device operable to allow a user to indicate at least two individual ones of said plurality of programs", "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu" as recited in claim 31, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 33, which depends directly from independent claim 31.

Therefore, the Appellant submits that claim 33, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

J. 35 U.S.C. § 102 - Claim 34.

Claim 34 depends directly from independent claim 31 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 31, the Appellant respectfully submits that dependent claim 34 is also not anticipated and is allowable for at least the reasons stated above with respect

to independent claim 31. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claim 31 further limited by "wherein said processor is further programmed to automatically transfer all programs comprising said list from a first storage medium to a second storage medium in response to a single user selection of said identifier" as recited in claim 34.

That is, and for at least the same reasons provided in Sections A and G above, at least because Ellis fails to teach, suggest or anticipate at least a method and system of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23 and "a display device capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content", "said device operable to allow a user to indicate at least two individual ones of said plurality of programs", "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu" as recited in claim 31, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 34, which depends directly from independent claim 31.

Therefore, the Appellant submits that claim 34, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

K. 35 U.S.C. § 102 - Claim 35

Claim 35 depends directly from independent claim 31 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 31, the Appellant respectfully submits that dependent claim 35 is also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 31. The Appellant further submits that Ellis also fails to teach,

suggest or anticipate the Appellant's claim 31 further limited by "wherein the processor is further programmed to allow said user to specify said identifier" as recited in claim 35.

That is, and for at least the same reasons provided in Sections A and G above, at least because Ellis fails to teach, suggest or anticipate at least a method and system of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23 and "a display device capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content", "said device operable to allow a user to indicate at least two individual ones of said plurality of programs", "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu" as recited in claim 31, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 35, which depends directly from independent claim 31.

Therefore, the Appellant submits that claim 35, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

L. 35 U.S.C. § 102 - Claim 36

Claim 36 depends directly from claim 32 which depends directly from independent claim 31 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 31 and dependent claim 32, the Appellant respectfully submits that dependent claim 36 is also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 31 and dependent claim 32. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claims 31 and 32 further limited by "wherein said first storage

medium is selected from the group comprising: optical disc media, magneto disc media, digital tape media, analog tape media, and hard disc drive(HDD)" as recited in claim 36.

That is, and for at least the same reasons provided in Sections A, G and H above, at least because Ellis fails to teach, suggest or anticipate at least a method and system of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23 and "a display device capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content", "said device operable to allow a user to indicate at least two individual ones of said plurality of programs", "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu" as recited in claim 31 and as further limited by the limitations of claim 32, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 36, which depends directly from clam 32 and indirectly from independent claim 31.

Therefore, the Appellant submits that claim 36, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

M. 35 U.S.C. § 102 - Claim 37

Claim 37 depends directly from claim 32 which depends directly from independent claim 31 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 31 and dependent claim 32, the Appellant respectfully submits that dependent claim 37 is also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 31 and dependent claim 32. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claims 31 and 32 further limited by "wherein said second

storage medium is selected from the group comprising: optical disc media, magneto disc media, digital tape media, analog tape media and hard disc drive(HDD)" as recited in claim 37.

That is, and for at least the same reasons provided in Sections A, G and H above, at least because Ellis fails to teach, suggest or anticipate at least a method and system of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23 and "a display device capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content", "said device operable to allow a user to indicate at least two individual ones of said plurality of programs", "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu" as recited in claim 31 and as further limited by the limitations of claim 32, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 37, which depends directly from clam 32 and indirectly from independent claim 31.

Therefore, the Appellant submits that claim 37, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

N. 35 U.S.C. § 102 - Claim 38

Claim 38 depends directly from independent claim 31 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 31, the Appellant respectfully submits that dependent claim 38 is also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 31. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claim 31 further limited by "wherein said steps are

accomplished without modifying video and audio program content of said indicated programs" as recited in claim 38.

That is, and for at least the same reasons provided in Sections A and G above, at least because Ellis fails to teach, suggest or anticipate at least a method and system of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23 and "a display device capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content", "said device operable to allow a user to indicate at least two individual ones of said plurality of programs", "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu" as recited in claim 31, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 38, which depends directly from independent claim 31.

Therefore, the Appellant submits that claim 38, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

O. 35 U.S.C. § 102 - Claim 39.

Claim 39 depends directly from independent claim 23 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 23, the Appellant respectfully submits that dependent claim 39 is also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 23. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claim 23 further limited by "transferring selected programs from a first storage medium to a second storage medium by selecting said identifier from said menu" as recited in claim 39.

That is, and for at least the same reasons provided in Section A above, at least because Ellis fails to teach, suggest or anticipate at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 39, which depends directly from independent claim 23.

Therefore, the Appellant submits that claim 39, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

P. 35 U.S.C. § 102 - Claim 40

Claim 40 depends directly from claim 39 which depends directly from independent claim 23 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 23 and dependent claim 39, the Appellant respectfully submits that dependent claim 40 is also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 23 and dependent claim 39. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claims 23 and 39 further limited by "wherein said transferring step further comprises the step of automatically transferring programs comprising said second list from said first storage medium to said second storage medium without any user interaction following user selection of said identifier" as recited in claim 40.

That is, and for at least the same reasons provided in Sections A and O above, at least because Ellis fails to teach, suggest or anticipate at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23 and as further limited by the limitations of claim 39, the Appellant respectfully submits that Ellis also

fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 40, which depends directly from clam 39 and indirectly from independent claim 23.

Therefore, the Appellant submits that claim 40, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

Q. 35 U.S.C. § 102 - Claim 41

Claim 41 depends directly from claim 39 which depends directly from independent claim 23 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 23 and dependent claim 39, the Appellant respectfully submits that dependent claim 41 is also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 23 and dependent claim 39. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claims 23 and 39 further limited by "wherein said first storage medium is selected from the group comprising: optical disc media, magneto disc media, digital tape medium, analog tape medium and hard disc drive (HDD)" as recited in claim 41.

That is, and for at least the same reasons provided in Sections A and O above, at least because Ellis fails to teach, suggest or anticipate at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23 and as further limited by the limitations of claim 39, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 41, which depends directly from clam 39 and indirectly from independent claim 23.

Therefore, the Appellant submits that claim 41, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

R. 35 U.S.C. § 102 - Claim 42

Claim 42 depends directly from claim 39 which depends directly from independent claim 23 and recites further limitations thereof. At least because teachings of Ellis fail to teach, suggest or anticipate the invention of the Appellant with regard to at least the Appellant's independent claim 23 and dependent claim 39, the Appellant respectfully submits that dependent claim 42 is also not anticipated and is allowable for at least the reasons stated above with respect to independent claim 23 and dependent claim 39. The Appellant further submits that Ellis also fails to teach, suggest or anticipate the Appellant's claims 23 and 39 further limited by "wherein said second storage medium is selected from the group comprising optical disc media, magneto disc media, digital tape medium, analog tape medium and hard disc drive (HDD)" as recited in claim 42.

That is, and for at least the same reasons provided in Sections A and O above, at least because Ellis fails to teach, suggest or anticipate at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23 and as further limited by the limitations of claim 39, the Appellant respectfully submits that Ellis also fails to teach, suggest or anticipate the Appellant's invention as claimed in dependent claim 42, which depends directly from clam 39 and indirectly from independent claim 23.

Therefore, the Appellant submits that claim 42, as it now stands, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

II. THE EXAMINER ERRED IN REJECTING CLAIMS 34 AND 40 UNDER 35 U.S.C. § 103(a) AT LEAST BECAUSE THE CITED REFERENCES, ALONE OR IN ANY ALLOWABLE COMBINATION, FAIL TO TEACH, SUGGEST OR MAKE OBVIOUS AT LEAST A METHOD AND SYSTEM OF CREATING A VIDEO PROGRAM LIST INCLUDING "CREATING A SECOND PROGRAM LIST, INCLUDING THE AT LEAST ONE IDENTIFIED PROGRAM", "CREATING AN IDENTIFIER CORRESPONDING TO SAID SECOND PROGRAM LIST" AND "INCLUDING SAID IDENTIFIER AS A SELECTABLE ITEM OF SAID MENU".

A. 35 U.S.C. § 103(a) - Claim 40

The Examiner rejected claim 40 under 35 U.S.C. § 103(a) as being unpatentable over Ellis in view of Okada (U.S. Patent 6,181,870). The rejection is respectfully traversed.

Claim 40 is a dependent claim which depends indirectly from the Applicant's independent claim 23. The Examiner applied Ellis to claim 40 as applied to reject the Applicant's claim 23. As recited in Section I(A) above and for at least the reasons recited above, the Applicant respectfully submits that Ellis fails to teach, suggest or anticipate at least the Applicant's claim 23. More specifically, Ellis absolutely fails to teach, suggest or disclose at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23. As such, the Applicant respectfully submits that at least because Ellis fails to teach, suggest or anticipate the Applicant's claim 23, the teachings of Ellis also fail to teach, suggest or anticipate the Applicant's claim 40, which depends directly from the Applicant's claims 23 and recites further limitation thereof. That is, the Appellant submits that Ellis fails to teach, suggest or make obvious the Appellant's claim 23 further limited by "wherein said transferring step further comprises the step of automatically transferring programs comprising said second list from said first storage medium to said second storage medium without any user interaction following user selection of said identifier" as recited in claim 40.

In addition, the Applicant further submits that Okada absolutely fails to teach, suggest or anticipate at least a method of creating a video program list including "creating said second program list, including the at least one identified program", "creating an identifier corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 23. More specifically, Okada discloses a video editing system that is intended for modification of video content down to the cell level. See Okada, Fig. 77B which shows a plurality of cells displayed and ready for editing. In DVD-Video, a cell is a group of pictures or audio blocks. Each cell is assigned a unique cell ID number and is the smallest addressable portion of video stored on the media. The cell ID numbers are not descriptive of the subject matter or artistic content of a recorded performance. Accordingly, they would be cumbersome at best for the purposes of creating a program play list.

Similarly, in DVD-Video it is well known that a video title typically contains up to 999 program chains (PGCs) of the kind that are illustrated in Okada's Fig. 77A. Each program chain or PGC contains up to 99 ordered collections of pointers to cells. Like the cell ID, however, PGCs are typically given generic number identifiers that are not descriptive of the subject matter or artistic content of a recorded title. In view of the foregoing, it is apparent that the video editing methods disclosed in Okada would not anticipate or make obvious the Applicant's claimed invention at least with respect the Applicant's claim 23, and as such claim 40, for creating user selectable play lists based on titles that are descriptive of the subject matter or artistic content of a recorded performance.

Therefore, the Applicant submits that Okada also fails to teach, suggest or make obvious the Applicant's claim 23, and as such claim 40, which depends indirectly from the Applicant's claim 23 and recites further limitations thereof.

As such, the Applicant submits that the teachings of Okada fail to bridge the substantial gap between the teachings of Ellis and the invention of the Applicant. That is, Ellis and Okada, alone or in any allowable combination, fail to teach, suggest or make obvious at least a method for creating a program list including "creating said second program list, including the at least one identified program", "creating an identifier

corresponding to said second program list" and "including said identifier as a selectable item of said menu" as taught in the Applicant's Specification and claimed by at least the Applicant's claim 23. As such, the Applicant respectfully submits that at least because the teachings of Ellis and Okada, alone or in any allowable combination, fail to teach, suggest or make obvious the Applicant's claim 23, the Applicant further submits that the teachings of Ellis and Okada, alone or in any allowable combination, also fail to teach, suggest or make obvious at least the Applicant's claim 40, which depends indirectly from the Applicant's claim 23, and recites further limitations thereof.

Therefore, the Applicant submits that for at least the reasons recited above dependent claim 40 is not rendered obvious by the teachings of Ellis and Okada, alone or in any allowable combination and, as such, fully satisfies the requirements of 35 U.S.C. § 103 and is patentable thereunder.

B. 35 U.S.C. § 103(a) - Claim 34

The Examiner rejected claim 34 under 35 U.S.C. § 103(a) as being unpatentable over Ellis in view of Okada (U.S. Patent 6,181,870). The rejection is respectfully traversed.

Claim 34 is a dependent claim which depends directly from the Applicant's independent claim 31. The Examiner applied Ellis to claim 34 as applied to reject the Applicant's claim 31. As recited in Section I(G) above and for at least the reasons recited above, the Applicant respectfully submits that Ellis fails to teach, suggest or anticipate at least the Applicant's claim 31. More specifically, Ellis absolutely fails to teach, suggest or disclose at least a system for generating a video recording and playback list including at least "a display device capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content", "said device operable to allow a user to indicate at least two individual ones of said plurality of programs", "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the

Appellant's claim 31. As such, the Applicant respectfully submits that at least because Ellis fails to teach, suggest or anticipate the Applicant's claim 31, the teachings of Ellis also fail to teach, suggest or anticipate the Applicant's claim 34, which depends directly from the Applicant's claims 31 and recites further limitation thereof. That is, the Appellant submits that Ellis fails to teach, suggest or make obvious the Appellant's claim 31 further limited by "wherein said processor is further programmed to automatically transfer all programs comprising said list from a first storage medium to a second storage medium in response to a single user selection of said identifier" as recited in claim 34.

In addition, the Applicant further submits that Okada absolutely fails to teach, suggest or anticipate at least a system for generating a video recording and playback list including at least "a display device capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content", "said device operable to allow a user to indicate at least two individual ones of said plurality of programs", "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu" as taught in the Appellant's Specification and claimed in at least the Appellant's claim 31. More specifically, Okada discloses a video editing system that is intended for modification of video content down to the cell level. See Okada, Fig. 77B which shows a plurality of cells displayed and ready for editing. In DVD-Video, a cell is a group of pictures or audio blocks. Each cell is assigned a unique cell ID number and is the smallest addressable portion of video stored on the media. The cell ID numbers are not descriptive of the subject matter or artistic content of a recorded performance. Accordingly, they would be cumbersome at best for the purposes of creating a program play list.

Similarly, in DVD-Video it is well known that a video title typically contains up to 999 program chains (PGCs) of the kind that are illustrated in Okada's Fig. 77A. Each program chain or PGC contains up to 99 ordered collections of pointers to cells. Like the cell ID, however, PGCs are typically given generic number identifiers that are not

descriptive of the subject matter or artistic content of a recorded title. In view of the foregoing, it is apparent that the video editing methods disclosed in Okada would not anticipate or make obvious the Applicant's claimed invention at least with respect the Applicant's claim 31, and as such claim 34.

Therefore, the Applicant submits that Okada also fails to teach, suggest or make obvious the Applicant's claim 31, and as such claim 34, which depends indirectly from the Applicant's claim 31 and recites further limitations thereof.

As such, the Applicant submits that the teachings of Okada fail to bridge the substantial gap between the teachings of Ellis and the invention of the Applicant. That is, Ellis and Okada, alone or in any allowable combination, fail to teach, suggest or make obvious at least a system for generating a video recording and playback list including at least "a display device capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content", "said device operable to allow a user to indicate at least two individual ones of said plurality of programs", "said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list" and "said processor programmed to modify said menu to include said identifier as a user selectable item of said menu" as taught in the Applicant's Specification and claimed by at least the Applicant's claim 31. As such, the Applicant respectfully submits that at least because the teachings of Ellis and Okada, alone or in any allowable combination, fail to teach, suggest or make obvious the Applicant's claim 31, the Applicant further submits that the teachings of Ellis and Okada, alone or in any allowable combination, also fail to teach, suggest or make obvious at least the Applicant's claim 34, which depends indirectly from the Applicant's claim 31, and recites further limitations thereof.

Therefore, the Applicant submits that for at least the reasons recited above dependent claim 34 is not rendered obvious by the teachings of Ellis and Okada, alone or in any allowable combination and, as such, fully satisfies the requirements of 35 U.S.C. § 103 and is patentable thereunder.

Conclusion

Thus, the Appellant submits that none of the claims presently in the application are anticipated under the provisions of 35 U.S.C. § 102 or rendered obvious under the provisions of 35 U.S.C. § 103. Consequently, the Appellant believes all these claims are presently in condition for allowance.

For the reasons advanced above, the Appellant respectfully urges that the rejections of claims 23-26, 30-33, 35-39 and 41-42 as being anticipated under 35 U.S.C. §102 are improper. The Appellant further urges that the rejections of claims 34 and 40 as being unpatentable under 35 U.S.C. §103 are improper. Reversal of the rejections in this Appeal is respectfully requested.

Respectfully submitted,

15 March 06
Date

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CLAIMS APPENDIX

23. (Previously Presented) A method of creating a video program list comprising the steps of:

presenting a menu including a first program list of recorded programs;

identifying each of said recorded programs in said menu using a title that refers to at least one of a subject matter and an artistic content of said recorded programs;

prompting a user to identify at least one recorded program from said first program list to be included in a second program list;

creating said second program list, including the at least one identified program;

creating an identifier corresponding to said second program list;

including said identifier as a selectable item of said menu.

24. (Previously presented) The method according to claim 23 wherein at least a first recorded program of said plurality of recorded programs is stored on a first storage medium and at least a second recorded program of said plurality of recorded programs is stored on a second storage medium.

25. (Previously presented) The method according to claim 23 wherein said programs are represented on said menu by means of a program title.

26. (Previously presented) The method according to claim 23, further comprising the steps of:

prompting said user to select an order for the programs comprising said second list; and

playing back the video programs comprising said second list in the selected order.

27-29 (Previously Cancelled)

30. (Previously Presented) A method of generating a video recording and playback list, comprising the steps of:

displaying a menu including a plurality of recorded programs;

identifying each of said recorded programs in said menu using a title that refers to at least one of a subject matter and an artistic content of said recorded programs;

creating a list comprising user identified ones of said plurality of recorded programs;

modifying said menu to include said list as a selectable item on said menu.

31. (Previously Presented) A system for generating a video recording and playback list comprising:

a display device capable of displaying a program menu including a plurality of individually selectable programs, each identified by a title that refers to least one of a subject matter and an artistic content,

said device operable to allow a user to indicate at least two individual ones of said plurality of programs;

said device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to said list;

said processor programmed to modify said menu to include said identifier as a user selectable item of said menu.

32. (Previously Presented) The system according to claim 31, wherein said processor is further programmed to transfer video programs corresponding to said indicated items from a first storage medium to a second storage medium in response to user selection of said identifier.

33. (Previously Presented) The system according to claim 31, wherein said device is operable to allow a user to order said indicated items and wherein said processor is further programmed to playback said programs according to said order in response to user selection of said identifier.

34. (Previously Presented) The system according to claim 31, wherein said processor is further programmed to automatically transfer all programs comprising said list from a first storage medium to a second storage medium in response to a single user selection of said identifier.

35. (Previously Presented) The system according to claim 31, wherein the processor is further programmed to allow said user to specify said identifier.

36. (Previously Presented) The system according to claim 32 wherein said first storage medium is selected from the group comprising: optical disc media, magneto disc media, digital tape media, analog tape media, and hard disc drive(HDD).

37. (Previously Presented) The system according to claim 32, wherein said second storage medium is selected from the group comprising: optical disc media, magneto disc media, digital tape media, analog tape media and hard disc drive(HDD).

38. (Previously Presented) The method of claim 23 wherein said steps are accomplished without modifying video and audio program content of said indicated programs.

39. (Previously Presented) The method according to claim 23 further comprising the step of transferring selected programs from a first storage medium to a second storage medium by selecting said identifier from said menu.

40. (Previously Presented) The method according claim 39, wherein said transferring step further comprises the step of automatically transferring programs comprising said second list from said first storage medium to said second storage medium without any user interaction following user selection of said identifier.

41. (Previously Presented) The method according to claim 39, wherein said first storage medium is selected from the group comprising: optical disc media, magneto disc media, digital tape medium, analog tape medium and hard disc drive (HDD).

42. (Previously Presented) The method according to claim 39, wherein said second storage medium is selected from the group comprising optical disc media, magneto disc media, digital tape medium, analog tape medium and hard disc drive (HDD).

EVIDENCE APPENDIX

Appellant asserts that there is no evidence to be submitted in this section.

RELATED PROCEEDINGS APPENDIX

Appellant asserts that there are no copies of decisions to be submitted in this section.